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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/800,779	03/15/2004	Welesson Andrade	14-0008	9195

40158 7590 12/20/2007
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SIOUX FALLS, SD 57117

EXAMINER

HAN, QI

ART UNIT	PAPER NUMBER
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2626

MAIL DATE	DELIVERY MODE
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12/20/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/800,779	Applicant(s) ANDRADE, WELESSON	
	Examiner Qi Han	Art Unit 2626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Response to Amendment

2. This communication is responsive to the applicant's amendment filed on 10/09/2007. The applicant(s) amended claims 1 and 5, and added new claims 8-12 (see the amendment: pages 2-5).

The examiner withdraws the previous claim rejection under 35 USC 112 2nd, because the applicant amended the corresponding claim(s).

Response to Arguments

3. Applicant's arguments filed on 10/09/2007 with respect to the claim rejection under 35 USC 102 and/or 103, have been fully considered but are moot in view of the new ground(s) of rejection, since the amended claims introduce new issue (or new matter), which changes the scope of the claims.

It is noted that the previous cited references are still applicable to the newly amended and added claims, because the disclosure of reference(s) covers the amended and argued limitation(s).

In response to the applicant's argument that the cited references "do not disclose the memory chip as recited" in the claims (see Remarks: page 7, paragraph 3), the examiner

disagrees with the applicant and has a different view of the prior teachings and claim interpretations. It is noted the JOHANSSON discloses that 'control block 860 may comprise a microprocessor ... memory (memory chip) and/or hard-wired digital logic' (Figs. 3 and 8 and col. 9, lines 62-64), wherein storing program and data (programmable responsive information) in a microprocessor-based device is necessary and/or inherent nature of the memory for the device, so that the disclosure is properly read on the claim based on broadest reasonable interpretation of claim(s) in light of the specification (see detail in the corresponding claim rejection under new ground below).

For at least above reason, the applicant's argument is not persuasive.

Claim Objections

4. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

In this case, the amendment includes two claims both numbered with 9. The misnumbered claim of the second claim 9 (see amendment: page 4), has been renumbered as claim 13 hereinafter. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 5, 8 and 13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claims 5 and 8, the limitation of “...enables programming **to be loaded onto said memory chip to provide instructions** for customized input...” introduces new subject matter, because it is not specifically disclosed/described in the original specification (see the closest disclosure of the specification: page 4, lines 25-27 and page 5, lines 16-21).

Regarding claim 13 (misnumbered as 9), the limitation of “the memory chip is programmable to receive additional data including spoken command input and audible response output” introduces new subject matter, because it is not specifically disclosed/described in the original specification (see the closest disclosure of the specification: page 4, lines 25-27 and page 5, lines 16-21).

6. Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 10, the recited limitation “a connection port in the earpiece such that the command processing unit and memory chip are operationally couplable to a remote computer to **permit** programming of the command processing unit **and** memory chip to **provide** customized input and responsive output” is indefinite, because it is unclear which of the multiple components would act “to permit ...” or “to provide...” For example, the limitation would at least mean “a connection port to permit...”, “the command processing unit and memory chip to permit...”, “a computer to permit...”, or “couplable to a remote computer to permit programming of the command processing unit **and** couplable to memory chip to provide customized input and responsive output”. The examiner cannot figure out which one is applicant’s claimed invention, so that the limitation is indefinite.

Claim Rejections - 35 USC § 102

7. Claims 1, 4, 9, 11 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by JOHANSSON et al. (US 6,243,670 B1) hereinafter referenced as JOHANSSON.

As per **claim 1**, JOHANSSON discloses ‘circuit assembly for effectuating communication between a first and a second locally-positioned communication device’(title), including a handset unit (Fig. 8) comprising:

an earpiece positionable adjacent to a user's ear (col. 10, lines 12-23 ‘earphones (earpiece)...to securely engage the user’s ear’);

a command processing unit (col. 9, lines 56-64, ‘controller block 86’);

a microphone positionable adjacent a mouth of the user when the earpiece is positioned adjacent the user's ear, the microphone being operationally coupled to the command processing

unit for providing the command processing unit with a voice command from the user (Fig. 8 and col. 10, lines 6-11, 'a swing-out microphone, flexibly mounted to the housing'; col. 15, lines 55-56, 'responsive to voice command of user'; also see Fig. 3);

a voice recognition assembly operationally coupled to the command processing unit for identifying the voice command from the user (Fig. 8 and col. 57 to col. 10, line 4, 'controller block 860 may comprise a microprocessor...and/or hard-wired digital logic', 'includes voice activation and voice recognition'; col. 15, lines 55-56);

a memory chip mounted on the earpiece and operationally coupled to the microprocessor for storing programmable responsive information (Figs. 3 and 8 and col. 9, lines 62-64, 'control block 860 may comprise a microprocessor ... memory (necessarily/inherently mounted on the earpiece for storing program and data—interpreted as programmable responsive information) and/or hard-wired digital logic'; col. 15, lines 55-56, 'voice command' is also read on the programmable responsive information);

an audio output assembly operationally coupled to the command processing unit and the earpiece for providing the responsive information to the user in an audio format upon receiving the voice command from the user (Fig.8 and col. 9, line 51 to col. 10, line 13, 'speaker 880 and the drive/amplifier block 850 (lines an audio output assembly)', 'earphones', and Fig. 8 shows the controller 860 is coupled to block 850 and then output to earphones (earpiece)).

As per **claim 4** (depending on claim 1), as state above, JOHANSSON discloses the microphone being positioned at a distal end of a flexible member for facilitating positioning of the microphone adjacent to the user's mouth (Fig 3 and col. 10, lines 6-11, 'a swing-out

microphone (at distal end)', which necessarily/inherently positioning the microphone adjacent to the user's mouth).

As per **claim 9**, the rejection is based on the same reason described for claim 1, because the claim recites the same or similar limitations as claim 1.

As per **claim 11** (depending on claim 9), the rejection is based on the same reason described for claim 4, because the claim recites the same or similar limitations as claim 4.

As per **claim 13** (depending on claim 9), as best understood in view of claim rejection under 35 USC 112 1st (see above), the rejection is based on the same reason described for claim 1, because the claim recites the same or similar limitations as claim 1 (see rejection for last two limitation elements of claim 1).

Claim Rejections - 35 USC § 103

8. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over JOHANSSON in view of SLOANE et al. (US 6,434,530 B1) hereinafter referenced as SLOANE.

As per **claim 2** (depending on claim 1), JOHANSSON does not expressly disclose the voice command being "a recipe name" and the responsive information being "a list of ingredients corresponding to the recipe of the voice command". However, the feature is well known in the art as evidenced by SLOANE who discloses 'interface shopping system with mobile apparatus' (title), comprising 'speech application' with 'speech recognition' and 'text-to-speech' (col. 6, lines 61-65); using 'voice command' and 'headset' (col. 12, lines 46-63); 'respond to questions' and 'generation of a recipe' on the basis of certain ingredients' (col. 7, lines 16-28). Therefore, it would have been obvious to one of ordinary skill in the art at the time

the invention was made to modify JOHANSSON by providing recipe/ingredients information to respond to question in a speech application using voice command capability, as taught by SLOANE, for the purpose (motivation) of influencing the article selection decisions and/or providing shopper with supplemental information requested to make intelligent shopping decisions (SLOANE: abstract and col. 2, lines 30-32).

9. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over JOHANSSON in view of AUGUST (US 2002/0094067 A1).

As per **claim 3** (depending on claim 1), JOHANSSON does not expressly disclose “the responsive information is a translation of the communication in a second language” However, the feature is well known in the art as evidenced by AUGUST E who discloses ‘network provided information using text-to-speech and speech recognition and text or speech activated network control sequences for complimentary feature access’ (title), comprising operating ‘voice command’ and ‘text-to-speech’ in ‘multiple languages’ (p12-p14), and ‘uttering the reserved words in another (second) language (a translation in a second language)’ (p55). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify JOHANSSON by providing capability of uttering the reserved words in another language for text-to-speech application (a translation of the communication in a second language), as taught by AUGUST, for the purpose (motivation) of performing text-to-speech conversion using an identified (or selected) language (AUGUST: abstract).

10. Claims 5 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over JOHANSSON:

As per **claim 5** (depending on claim 1), as best understood in view of claim rejection under 35 USC 112 1st (see above), even though JOHANSSON discloses “a connection port in the earpiece communication with the memory such that connection of said connection port to a remote computer enable programming” (see rejection of last two limitation elements of claim 1; and Fig. 14, blocks 1410 and 1430, ‘interface (a connection port)’ and ‘computer device (remote computer)’); also see col. 9, lines 62-64), JOHANSSON does not expressly disclose “to be loaded onto said memory chip to provide instructions for customized input and responsive output by said headset.” However, it is noted that JOHANSSON discloses that ‘a controller block 860 may comprise a microprocessor...memory...’ (Fig. 8 and col. 9, lines 62-64) and ‘module 1405 also possesses capability to receive and transfer (output) data and/or voice for communication by the headset’ with ‘a computer device’ (Fig. 14 and col. 13, lines 40-60). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to recognize that capability of receiving/transmitting data/voice for communication would include capability of receiving (loading) customized input data and related output, and to combine the different teachings of JOHANSSON by providing the capability of programming and receiving (loading or providing) customized input and related output, for the purpose (motivation) of communicating with other devices in an integrated communication system and/or within a distributed computing environment (JOHANSSON: abstract: col. 6, lines 47-50).

As per **claim 10** (depending on claim 9), as best understood in view of claim rejection under 35 USC 112 2nd (see above), the rejection is based on the same reason described for claim 10, because the claim recites the same or similar limitations as claim 10.

11. Claims 6-7 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over JOHANSSON in view of COURTIS et al. (US 6,377,820 B1) hereinafter referenced as COURTIS.

As per **claim 6** (depending on claim 1), JOHANSSON does not expressly disclose “the earpiece is structured to rest in the ear of the user.” However, the feature is well known in the art as evidenced by COURTIS who discloses ‘radio telephone’ (title), comprising ‘headset’ that includes an in-ear speaker (earpiece)’ (Fig. 1 and col. 1, lines 12-14). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify JOHANSSON by providing the headset with an in-ear speaker, as taught by COURTIS, for the purpose (motivation) of providing a comfortable headset for the user (COURTIS: col. 2, lines 20-21).

As per **claim 7** (depending on claim 6), JOHANSSON in view of COURTIS further discloses that the microphone is positioned on a distal portion of a flexible member extending from the earpiece (JOHANSSON: Fig 3 and col. 10, lines 6-11, ‘the wireless headset may include two earphones, a swing-out microphone (at distal end), flexibly mounted to the housing’).

As per **claim 12** (depending on claim 9), the rejection is based on the same reason described for claim 6, because the claim recites the same or similar limitations as claim 6.

12. Claims 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over JOHANSSON in view of AUGUST and COURTIS.

As per **claim 8** (depending on claim 1), the rejection is based on the same reason described for claims 3-6, because the claim recites the same or similar limitations as claims 3-6.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. Please address mail to be delivered by the United States Postal Service (USPS) as follows:

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Art Unit: 2626

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Effective January 14, 2005, except correspondence for Maintenance Fee payments, Deposit Account Replenishments (see 1.25(c)(4)), and Licensing and Review (see 37 CFR 5.1(c) and 5.2(c)), please address correspondence to be delivered by other delivery services (Federal Express (Fed Ex), UPS, DHL, Laser, Action, Purolater, etc.) as follows:

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Qi Han whose telephone numbers is (571) 272-7604. The examiner can normally be reached on Monday through Thursday from 9:00 a.m. to 7:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richemond Dorvil, can be reached on (571) 272-7602.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Inquiries regarding the status of submissions relating to an application or questions on the Private PAIR system should be directed to the Electronic Business Center (EBC) at 866-217-9197 (toll-free) or 703-305-3028 between the hours of 6 a.m. and midnight Monday through Friday EST, or by e-mail at: ebc@uspto.gov. For general information about the PAIR system, see <http://pair-direct.uspto.gov>.

QH/qh
December 17, 2007


RICHEMOND DORVIL
SUPERVISORY PATENT EXAMINER